

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed May 18, 2005 ("Office Action"). Claims 1-37 are pending in the present application and currently stand rejected.

Specification Objection

The Office Action presented an objection to the specification. Applicants have amended the specification in accordance with the suggestions presented in the Office Action. Accordingly, Applicants request removal of this objection.

Section 103 Rejections

Claims 1, 5, 6, 11, 13, 24 and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,748,076 issued to Elo ("Elo") in view of U.S. Patent No. 6,212,272 issued to Herschler, et al. ("Herschler"). Claims 1, 4, 5, 6, 11, 13, 14, 16, 19, 21, 23, 24-26, 28, 30, 33, 35, 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,418,221 issued to Snow, et al. ("Snow") in view of *Herschler*. Applicants respectfully traverse these rejection for the reasons stated below.

Independent Claim 24 is allowable because the combinations of *Elo* and *Herschler* or *Snow* and *Herschler* fail to disclose a first output port having a load impedance in the first frequency band approximately between a first value associated with a first modulation technique and a second value associated with a second modulation technique. The Office Action acknowledges that neither combination teaches the above limitation. *See* Office Action, Page 7 for *Elo* and *Herschler* and Page 19 for *Snow* and *Herschler*. Rather, in order to supply the missing teaching, the Office Action indicates the following:

"... although the combination of [the references] does not teach expressly a,(sic) averaging method of determining an optimum load impedance of the first frequency band when the first and second modulation techniques are applied to the first circuit, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use any known method including the averaging method to determine the common

value of the load impedance to minimize the reflections due to mismatch of the load impedances".

Id. Applicants submit that such reasoning is simply speculative hindsight reconstruction. This conclusion falls well short of the required evidence necessary to establish a *prima facie* rejection. None of the references cited by in the Office Action teach or suggest that a circuit that can be utilized with two modulation techniques. At best, *Herschler* recognizes the existence of two modulation techniques, namely 2B1Q in North America and 4B37 in Europe and Japan. *See Herschler*, Column 3, lines 40-56. However, *Herschler* does not recognize that a single circuit can be utilized with both. Accordingly, without the Applicants' specification in hand, one of ordinary skill in the art would not be motivated to use a structure that places a load impedance between a value associated with each respective modulation technique.

Applicants remind the Examiner that mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination or modification. *See, e.g., In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at the claimed...salt."). The proposed modification presented in the Office Action, is void of any evidentiary support for such a modification.

Applicants additionally remind the Examiner that "[t]he factual inquiry whether to combine references must be thorough and searching." (*In re Sang-Su Lee*, 277 F.3d 1338, 1343). And that "[an] examiner's conclusory statements . . . do not adequately address the issue of motivation to combine." *Id.* Furthermore, simple hindsight speculation that "it would have been obvious" to make the proposed combination is insufficient under M.P.E.P.¹ guidelines and governing Federal Circuit case law.² Moreover, such statements

¹ *See, e.g.*, M.P.E.P. §2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

and assumptions are inadequate to support a finding of motivation, which is a factual question that cannot be resolved on “subjective belief and unknown authority.”³

For the above reasons, Applicants submit that Claim 24 and its dependents, Claims 25-29, are allowable. Independent Claim 14 and amended Independent Claims 1 and 30 are allowable for analogous reasons as are there dependents, Claims 2-13, 15-23, and 31-37.

Several dependent claims were additionally rejected under 35 U.S.C. § 103(a). These rejections are moot because the independent claims from which they depend are allowable, as described above.

Request for Evidentiary Support

Should a rejection based on any of the above assertions be maintained, Applicants respectfully request appropriate evidentiary support. Additionally, if the Office Action is relying upon “common knowledge” or “well known” principles to establish the rejection, Applicants request that a reference be provided in support of this position pursuant to M.P.E.P. § 2144.03. Furthermore, to the extent that the Examiner maintains any rejection based on an “Official Notice” or other information within the Examiner’s personal knowledge, Applicants respectfully request that the Examiner cite a reference as documentary evidence in support of this position or provide an affidavit in accordance with M.P.E.P. § 2144.03 and 37 C.F.R. 1.104(d)(2).

² For example, in *In re Dembiczkak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant’s invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted).

³ See *In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

CONCLUSION

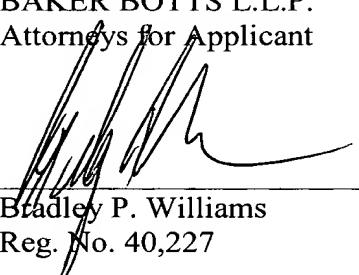
Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Brad P. Williams, Attorney for Applicants, at the Examiner's convenience at (214) 953-6447.

Although no fees are believed due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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